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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,899

09/14/2006

Yasuhito Inagaki

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EXAMINER

LEE, DORIS L

ART UNIT

PAPER NUMBER

1764

MAIL DATE

DELIVERY MODE

05/07/2012

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,899	Applicant(s) INAGAKI, YASUHIITO	
	Examiner DORIS LEE	Art Unit 1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-14,30-33,35-39 and 42-45 is/are pending in the application.
- 5a) Of the above claim(s) 1-14 is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 30-33,35-39 and 42-45 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07232010, 09142011</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 20, 2012 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 33** is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Regarding claim 33, it is noted that this claim (which depends on claim 30), indicates that the aromatic polymer has an aromatic skeleton in the main chain, however, this does not further limit claim 30 which states that the aromatic skeleton is in the side chain. As indicated in applicant's specification on page 37, the aromatic skeleton can *either* be in the side chain or the main chain and not both.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 30-32, 35-39 and 42-45** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kitayama et al (WO 2001/27201, please see US 6,827,882 for the English language equivalent and mapping).**

Regarding claim 30, 31, Kitayama teaches a resin composition having flame retardant properties (Abstract) which has a flame retarder which includes an aromatic polymer such as polystyrene (col. 4, line 67) which has monomer units having aromatic skeletons. Kitayama teaches that the polystyrene can be a homopolymer (col. 5, line 39). The sulfonic acid groups are present in the amount from 0 to 100 % (col. 5, lines 1-20).

Regarding claim 32, Kitayama teaches that the aromatic polymer has a weight average molecular weight from 1,000 to 300,000 (col. 5, lines 60-63).

Regarding claim 35 and 36, as claims 35 and 36 are product-by-process claims; patentability of said claims is based on the recited product and does not depend on its method of production. Since the product as claimed is the same as product disclosed by Kitayama the claim is unpatentable even if the Kitayama product was made by a different process. In re Marosi, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

Regarding claim 37, 38, Kitayama teaches a resin (Abstract) which has a flame retarder which includes an aromatic polymer such as polystyrene (col. 4, line 67) which has monomer units having aromatic skeletons. Kitayama teaches that the polystyrene

can be a homopolymer (col. 5, line 39). The sulfonic acid groups are present in the amount from 0 to 100 % (col. 5, lines 1-20).

Regarding claim 39, Kitayama teaches that the aromatic polymer has a weight average molecular weight from 1,000 to 300,000 (col. 5, lines 60-63).

Regarding claim 42 and 44, as claims 42 and 44 are product-by-process claims, patentability of said claims is based on the recited product and does not depend on its method of production. Since the product as claimed is the same as product disclosed by Kitayama the claim is unpatentable even if the Kitayama product was made by a different process. In re Marosi, 710 F2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). See MPEP 2113.

Regarding claim 43, Kitayama teaches that the resin has 90-99.98 % by weight of polycarbonate (col. 3, lines 25-27).

Regarding claim 45, Kitayama teaches that the composition further comprises a fluoro olefin resin as an anti-drip agent (col. 6, lines 30-40).

Response to Arguments

6. Applicant's arguments have been considered but are moot because the arguments do not apply to any of the references being used in the current rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DORIS LEE whose telephone number is (571)270-3872. The examiner can normally be reached on Monday - Thursday 7:30 am to 5 pm and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Doris L Lee/
Primary Examiner, Art Unit 1764